

**REMARKS/ARGUMENTS**

Claims 1, 12, 15, 23, 25 and 27 have been amended. Claims 29-31 have been added. Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. Rejection of Claim 23 under 35 U.S.C. § 112

Claim 23 has been amended to correct the informalities identified by the Examiner. As these informalities have been corrected, removal of the rejection of claim 23 under 35 U.S.C. § 112 is respectfully requested.

2. New Claims

Claims 29-31 have been added to more clearly present the invention. Support for the new claims can be found with reference to page 13, line 24 to page 14, line 10 of the originally filed application for this case. No new matter has been added.

3. Rejection of Claims 1, 2, 12, 13 and 23 under 35 U.S.C. § 102(e).

Claims 1, 2, 12, 13 and 23 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Eggleton et al. (U.S. No. 6,293,728). Such rejection is traversed in part and overcome in part as follows:

Independent Claims 1, 12 and 23, as currently amended, are directed to an apparatus for impressing a three dimensional pattern into a wet concrete wall formed by a slip form, the apparatus having an impression roller having an axis and an outer periphery impressed with a three dimensional pattern. In particular, Claims 1, 12 and 23 each recite a means for supporting the roller for rotation about the axis with the outer layer being partially depressed into an exposed side surface of the wet concrete wall just emerging from the slip form. Such structure is not present in the Eggleton et al. reference.

A single cited art reference must teach each and every element of the claim to establish anticipation under 35 U.S.C. §102. M.P.E.P. §2131. The Court of Appeals for the Federal Circuit has held that, "the identical invention must be shown in as

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complete detail as is contained in the .... claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). The Eggleton et al. reference is directed to a curb forming apparatus having a device for pushing a hardenable material through a channel in the side of the curb. (see col. 1, lines 29-31, and Fig. 1). Eggleton et al. discloses a stamp apparatus applying a downward force to create a decorative impression on the top of the extruded curb. (see col. 7, line 65 to col. 8, line 21). The Eggleton et al. reference is devoid any discussion of impressing a pattern into a slip form wall, nonetheless a side surface of a wet concrete wall emerging from a slip form.

Accordingly, the Applicant respectfully submits that Claims 1, 12, and 23, as well as Claims 2, 4-6, 8, 13, 15-17, and 19 dependant therefrom, are not anticipated by Eggleton et al.

4. Rejection of Claims Rejection of Claims 4-6, 8, 15-17, 19, and 26-28 under U.S.C. § 103(a)

(a) Claims 5, 16, 25 and 27. Claims 5, 16, 25 and 27 were rejected under §103(a) as allegedly being unpatentable over Eggleton et al. The Examiner concedes that Eggleton et al does not disclose "upper and lower arms rotatably attached to the upper and lower ends of the roller". Office Action dated April 22, 2004, page 4. To cure this deficiency, the Examiner states that "any exposed surface (e.g. vertical) of the extruded concrete may be permitted by appropriate orientation of the impression roller." Applicants respectfully disagree.

Firstly, the Office Action fails to show all of the limitations recited by the claims. As clearly stated in M.P.E.P. § 2143, *prima facie* obviousness under 35 U.S.C. §103 requires that the combined references teach or suggest all of the claim limitations. M.P.E.P. § 2143.03, *In re Royka*, 180 U.S.P.Q 580 (CCPA1974). Claims 5, 16, 25, and 27 all recite depressing an impression roller into an exposed surface of wet concrete emerging from a slip form. Eggleton et al. is curb forming apparatus, not a slip form wall forming apparatus, which has different purposes and requirements. The Eggleton

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et al. apparatus forms curbs useful in landscaping for sidewalks, gardens etc. The curbs generally have a constant height that is less than or similar to its width. (see col. 6, line 44 to col. 7, line 3, and Figures 1-12). Conversely, slip-formed walls are typically used as freeway divider walls between opposing directions of traffic, retainer walls and barrier walls along property lines. (see current application, page 2, lines 5-9). Slip form walls may vary in height depending on the terrain, and the height of the wall is typically much greater than the width, sometimes over 8 feet tall (see Fig. 1, and the associated text on page 3, lines 1-9). Such height to width ratios can create complications for impressing the side of the wall that would not be found in a curb, because lateral displacement of the viscous wall may occur due to the forces created by the impression roller (see page 13, line 24 to page 24, line 10). Because the Eggleton et al. reference is devoid any discussion of any other type of barrier other than curbs, it fails to teach or suggest all of the recited claim limitations.

Secondly, one skilled in the art would not be motivated to modify the Eggleton et al. device as suggested by the Examiner. Even assuming, *arguendo*, that Eggleton et al. teaches all the recited elements of the claimed invention, M.P.E.P. § 2143 requires that there must be some motivation or suggestion to combine or modify the elements in a manner contemplated by the claim. M.P.E.P. § 2143.03, *In re Fine*, U.S.P.Q.2d 1596 (Fed. Cir. 1988). Eggleton et al. is directed to a curb forming apparatus with a grooving mechanism to place tubing such as lighting and/or irrigation lines into a groove or channel formed along the side of the curve. (see Figs. 12-13, and the associated text in col. 6, lines 22-28). It would be counterintuitive to imprint the side of curb in the Eggleton et al. apparatus because the channel and irrigation/lighting line located on the side wall would hinder creating an impression in the cement. Furthermore, the force of the impression roller necessary to imprint the cement may push the irrigation and/or irrigation lines to a depth in the cement that is neither optimal nor functional. Therefore, Eggleton et al. teaches away from reorienting the impression roller to create a three-dimensional imprint in the side of a wall or curb.

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For the forgoing reasons, a *prima facie* case of obviousness has not been established for Claims 5, 16, 25 and 27. Therefore, rejection under § 103(a) is improper.

(b) Claims 4, 6, 8, 15, 17, 26 and 28. Claims 4, 15, 26 and 28 were rejected as allegedly being unpatentable over Eggleton et al. (U.S. No. 6,293,728) in view of Jordan (U.S. Patent No. 5,033,906), and any one of several Nuata et al. (U.S. Patent No. 4,211,743), and Nuata (U.S. Patent No. 3,893,795 and U.S. Patent No. 3,605,194). Claims 6, 8, 17 and 19 were rejected as allegedly being unpatentable over Eggleton et al. (U.S. No. 6,293,728) in view of any one of Jordan (U.S. Patent No. 5,033,906), Meirick (U.S. Patent No. 5,421,670), and Moorhead (U.S. Patent No. 3,832,079). For many of the reasons explained above for claims 5, 16, 25 and 27, the cited references fail to teach or suggest all the claim limitations, nor is there the requisite suggestion or motivation to support combining the references in a manner contemplated by the claims. Therefore, rejection of Claims 4, 6, 8, 15, 17, 26 and 28 under § 103(a) is improper.

### 3. Conclusion.

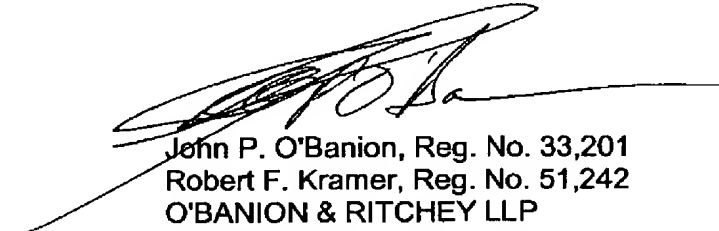
In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

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The Applicant also respectfully requests a telephone interview with the Examiner in the event that there are questions regarding this response, or if the next action on the merits is not an allowance of all pending claims.

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Respectfully submitted,

A handwritten signature in black ink, appearing to be 'J. P. O'Banion', is written over the typed name and address.

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